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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,533	07/06/2001	William J. Benton	00087CIP	3941

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

42-8

# Office Action Summary

Application No.

900533

Applicant(s)

BENTON ET AL

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 59 is/are pending in the application.
- Of the above claim(s) 11 - 24, 44 - 52 and 58 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 - 3, 5 - 10, 25 - 43, 53 - 57 and 59 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 6
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there would be no serious burden upon the examiner to perform the additional search. This is not found persuasive because the search is not limited to only one class in 507. As such the search of additional classes in other areas such as class 166, would be an extremely enormous burden upon the patent office.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims fail specify the quantities of the density levels, such as in g/ cm cubed or ppg etc.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-3, 5, 6, 9, 10, 25-28, 34, 35, 37-41, 53, 54 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/09253.

WO '253 teaches a composition which is used to dissolve filter cakes in well bores which comprises potassium formate or cesium formate, and citric acid, which is both an acid and chelating agent (see pages 17-18). A combination of cesium formate and potassium formate for use in the composition is also disclosed (see page 4, lines 19-23).

6. Claims 25, 28, 32, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2314865.

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GB '865 teaches a composition which comprises potassium formate and a chelant such as diethylenetriamine pentaacetic acid (see page 10). Applicants intended use as a completion fluid does not distinguish (In re Pearson 181 USPQ 641).

7. Claims 25, 26, 28, 29, 32, 34-38, 40, 42, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Hallman, Formates in Practice: Field Use and Reclamation, World Oil, October 1996, Pages 81-90.

Hallman teaches the reclamation of formate brines, in which formic acid is added to the spent brine which contains filter cake and calcium carbonate (page 88, column 3).

8. Claims 25, 26, 29 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/31435.

WO '435 teaches a composition which comprises cesium formate and formic acid (pages 20 and 22). Applicants intended use as a completion fluid does not distinguish (In re Pearson 181 USPQ 641).

9. Claims 25, 30, 31, 32 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Lau (5184679).

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Lau teaches a wellbore fluid composition which comprises sodium formate and citric acid, which is both an acid and chelating agent (see page 8, lines 16-52). Applicants intended use as a completion fluid does not distinguish (In re Pearson 181 USPQ 641).

10. Claims 1, 3, 5-10, 25-32, 34-43, 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Parlar et al. (US 2001/0036905 A1).

Parlar teaches a filtercake cleanup composition which comprises a breaker such as a chelating agent, HCl or formic acid, and a brine which can comprise potassium formate or cesium formate (see paragraph 0036, 0015 and 0043. A specific example of a mixture of a potassium and cesium formate brine is given (see paragraph 0062).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallman, Formates in Practice: Field Use and Reclamation, World Oil, October 1996, Pages 81-90.

Hallman teaches the reclamation of formate brines, in which formic acid is added to the spent brine which contains filter cake and calcium carbonate (page 88, column 3). Hallman differs from the present invention in that a specific level of formic acid used in the spent fluid is not disclosed. However, it would be obvious to one of ordinary skill in the art to vary the amount of formic acid in the spent fluid of Hallman, in order to achieve optimum reclamation of the formate salt from the spent fluid (In re Aller 105 USPQ 233).

13. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2719  
January 24, 2003

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.